REMARKS

This Amendment, filed in reply to the Office Action dated July 31, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-31 are all the claims pending in the application.

I.   Claim Rejections under 35 U.S.C. § 112

Claims 1-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts that claims 1 and 16 recite "the image database server having functions of receiving the sets of medical image data and accompanying information regarding thereto," however, the Examiner asserts that the server has not yet received any image data from the client terminal.

Contrary to the Examiner's assertions, claims 1 and 16 recite "the client terminals having an ability of transmission and reception of sets of medical image data together with accompanying information regarding the sets of medical image data via a network." Therefore, claims 1 and 16 recite the capability of the client terminals to transmit data to the image database server. Moreover, the claims are carefully drafted to cover metes and bounds of the invention. The Examiner is not permitted to narrow the scope of the claims by requiring the Examiner's own interpretation of the invention to be applied to the claim recitations. Further, the Examiner is not permitted to narrow the scope of the claims by trying to incorporate the features in the specification into the claims.

Consequently, Applicant submits that claims 1 and 16 are not indefinite and further amendment is not required.

With respect to claim 15, the Examiner asserts it is unclear how and where the medical

image information and the search condition are transmitted and who is receiving the medical

image data.

Claim 15 recites:

```
     A computer-readable recording medium storing a
program to cause a computer to execute the procedures
of:
     transmitting sets of medical image data together
with accompanying information regarding the sets of
the medical image data to an image database server via
a network;
     transmitting a search condition using the
accompanying information used for searching for a
desired one of the sets of the medical image data
stored in the image database server; and
     receiving the set of the medical image data
corresponding to the search condition,
     wherein the accompanying information includes at
least one of facility information and an input
modality.
```

Therefore, a computer executes the recitations of claim 15. Moreover, the medical image

data is transmitted from a computer to an image database server. In an exemplary embodiment

of the Applicant's invention, the computer can be a client terminal in a hospital. However, the

Applicant is not required to narrow the scope of the invention merely because of the Examiner's

interpretation of the invention.

Consequently, Applicant submits that claim 15 is not indefinite.

The Examiner further asserts that the recitation "storing therein the received sets of

medical image data" of claims 1 and 16 is indefinite.

Claim 1 recites:

"...the image database server having functions of <u>receiving</u>
<u>the sets of medical image data</u> and accompanying information
regarding thereto, both of which are transmitted from the client
terminals via the network, <u>storing therein the received sets of</u>
<u>medical image data</u> and the accompanying information that have
been received, searching for a desired one of the sets of
medical image data stored therein by using the accompanying
information, and transmitting the set of medical image data..."

Therefore, Applicant submits that claim 1 contains sufficient antecedent basis.

Applicant has amended claim 16 as indicated above. Applicant believes that the

amendment to claim 16 sufficiently addresses the antecedence issue raised by the Examiner.

For at least the above reasons, Applicant requests that the § 112, second paragraph

rejection of claims 1-27 be withdrawn.

II.   Claim Rejections under 35 U.S.C. § 103

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Teshima

(U.S. Patent No. 6,272,470) in view of Sota et al. (U.S. Patent No. 5,911,687).

Applicant notes that the Examiner rejects claims 1-27 under the same grounds as

previously presented. Moreover, the current Office Action does not address the limitations of

claims 1, 15, and 16 as amended in the Amendment under 37 C.F.R. § 1.114(c) filed along with

the RCE on April 21, 2006.

Therefore, Applicant requests that the Examiner establish where the recitation "wherein

the accompanying information includes at least one of facility information and an input

modality" is disclosed in the cited art. Since the Examiner has failed to establish where this

aspect of the claim is disclosed in the cited art, claims 1, 15, and 16 and their dependent claims

12

should be deemed allowable or any subsequent Office Action should be made on a non-final basis.

Moreover, as previously submitted, neither Teshima nor Sato disclose the use of accompanying information, where the accompanying information includes at least one of a facility information or an input modality, as recited in claim 1. Applicant submits that such features were previously recited in claim 3. In the rejection of claim 3, the Examiner merely maintains that Teshima discloses the claimed "patient specification information" (pg. 5 of Office Action). However, even if assuming *arguendo* Teshima does disclose a type of patient specification information, the reference still fails to teach or suggest that at least one of a facility information or an input modality is included in the accompanying information. Since Sato fails to cure this deficient teaching of Teshima, Applicant submits that claim 1 is patentable over the cited references.

In addition, Applicant submits that where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. MPEP 707.07(f). The Examiner has not addressed all of our arguments as presented in the Amendment under 37 C.F.R. § 1.114(c). Consequently, Applicant respectfully requests that the Examiner address all of the previously submitted arguments as discussed below.

Claim 1 recites:

> "...when a desired search condition is inputted
> from any one of the client terminals and is
> transmitted to the image database server, the image
> database server searches for the **accompanying
> information** using the desired search condition
> received by the image database server, if the

accompanying information is successfully found, then
retrieves the **medical image data** regarding the
accompanying information, and transmits the retrieved
medical image data to the relevant client terminal."

The Examiner concedes that Sato does not disclose that the medical data of the patient is

accompanied with information regarding the set of medical data and cites Teshima to cure the

deficiency. The Examiner reasons that Teshima discloses a system that stores patient image

information on a patient card and link information (address or file name) is produced with the

image data upon writing the data image information in the database server. The data image

information can then be accessed externally using the link information.

Applicant submits that Sato teaches away from transmission of image data based on

client terminal request. Rather, to maintain patient confidentiality, the transfer of information is

made through the central server as an intermediary based on phone requests by a patient for

appointments. Col. 6, line 41 to col. 7, lines 9; col. 5, lines 52-58. Therefore, the interchange

between client and server is constrained in Sato and does not teach each feature of the client

server interaction.

Assuming *arguendo*, that the references may be combined, contrary to the Examiner's

assertion, there is no indication that image data is necessarily stored on a patient card. In

particular, image data is too large to be stored on a patient card and is therefore stored externally.

Access to the image data is obtained via a link. See Teshima col. 4, lines 48-55.

Further, the image data of Teshima is obtained via a link and not by a search according to

patient to be examined (search condition as cited by the Examiner). In Teshima, when a link to

an image is selected, the image is directly provided to the user. A search for accompanying

information is not performed.

Assuming *arguendo* Teshima discloses searching for the accompanying information using the desired search condition received by the image database server, if the accompanying information is successfully found, then retrieves the medical image data regarding the accompanying information, the combination of Teshima with Sato is not obvious. In particular, there is no teaching or suggestion in Sato Figs. 20 and 21, of obtaining medical image data. At most, treatment information such as prescription, inspection and operation, are disclosed. Consequently, modifying Sato to include the teachings of Teshima is clearly a result of impermissible hindsight upon viewing the Applicant's invention.

For at least the above reasons, claim 1 and its dependent claims should be deemed allowable. To the extent claims 15 and 16 recite similar elements, they should be deemed allowable for at least the same reasons.

Claim 19

Claim 19 recites "wherein a user inputs a password onto an input device on said client terminal, wherein said client terminal transmits said password to said image database server." The Examiner asserts that Sato col. 14, lines 25-30 teaches this aspect of the claim. The respective column and lines cited by the Examiner discloses that as a result of a query and reference to image data, a doctor gives a diagnosis of a disease. The doctor then notifies the management center and requests an access right to the case database on the integrated management server. The management center receiving the request then gives the doctor access rights to the database. However, there is no teaching or suggestion of a user inputting a password onto an input device, let alone a client terminal transmitting the password to the image database server.

For at least the above reasons, claim 19 should be deemed allowable. In addition,

Applicant submits that claim 19 is patentable at least by virtue of its dependency upon claim 1.

Claim 21

Claim 21 recites that the "accompanying information is directly attached to said image

data." The Examiner asserts that in Teshima, patient image information is stored in a patient

card and link information is produced with the image data upon writing the data image

information to the database server and the data image information can be accessed externally

using the link information. However, as indicated by the Examiner, access to the external image

data is obtained via a link. Upon selecting a link, which is on a patient card, a user will be

directed to the desired image data. The image data is stored externally and is not directly

attached to the link information.

For at least the above reasons, claim 21 should be deemed allowable. In addition,

Applicant submits that claim 21 is patentable at least by virtue of its dependency upon claim 1.

Claim 24

Claim 24 recites "wherein the medical image data and the accompanying information are

managed as two separate files by using a common management number." The Examiner cites

Teshima, col. 8, line 48 to col. 9, line 38, for teaching this aspect of the claim. Further, the

Examiner reasons that in Teshima, patient image information is stored on a patient card, link

information is provided with the image data upon writing the data image information in the

database server, and wherein the data image information can be accessed externally using the

link information. The Examiner asserts that such image data information is associated with the

patient in the patient card.

16

However, there is no teaching or suggestion in Teshima that the link information

(medical image data as cited by the Examiner) and the accompanying information are managed

as two separate files by using a common management number, as recited in claim 24.

For at least the above reasons, claim 24 should be deemed allowable. In addition,

Applicant submits that claim 24 is patentable at least by virtue of its dependency upon claim 1.

III.   New Claim

Applicant has added claim 28-31 to provide a more varied scope of protection. Claims

28-31 should be deemed allowable by virtue of their dependency to claim 1 for at least the

reasons set forth above. Moreover, the art cited by the Examiner does not teach the elements of

claims 28 -31.

IV.   Conclusion

In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC

Telephone: (202) 293-7060

Facsimile: (202) 293-7860
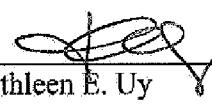
Ruthleen E. Uy

Registration No. 51,361

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 31, 2007